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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/255,277    02/23/99    YALE

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EXAMINER

CULBRETH, E

ART UNIT

PAPER NUMBER

3611

DATE MAILED:

06/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/255,277

Applicant(s)

Yale

Examiner

Eric Culbreth

Group Art Unit

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☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

The declaration should include the wording above and refer to the applications being relied upon as parents by application serial number.

### ***Priority***

2. Page 1, line 6 of the specification lists 164,806 as one of the cases of which this case is a continuation-in-part. However, the series number (i.e., 07, 06, etc.) is not given and should be supplied with applicant's next correspondence.

### ***Information Disclosure Statement***

3. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate

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paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

This refers to pages 1-2 of the specification.

### ***Drawings***

4. The drawings are objected to because they are replete with inaccuracies, incorrect and missing lead lines, and missing and mislabeled reference numerals. Some examples are given below, but the specification should be carefully reviewed and compared to the drawings to ensure that the drawings and specification agree.

Correction is required.

- a. In Figure 2, reference numeral 16 has no lead line.
- b. In Figures 1-3, the lead lines for reference numeral 1 should touch the part they refer to or have an arrow.
- c. Reference numeral 24 (page 8, lines 14-15 and throughout the remainder of the specification) is not on the drawings.
- d. The bellows are labeled 17 and 18 in Figure 2, but labeled 18 and 29 in Figure 5 (note page 8, lines 15-16 and the remainder of the specification). Only one reference numeral should refer to a part of the invention.
- e. Reference numeral 59 (page 9, line 15 and throughout the remainder of the specification) is not the drawings.

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- f. In Figure 3, the lead line for reference 13 should touch the part to which it refers.
- g. Regarding page 9, lines 28 and 30 and the rest of the specification, reference numerals 24 and 31 are not on the drawings (incidentally, if there are only two leaf springs disclosed, it is not clear why there are three reference numerals referring to them ("16, 24, and 31 at page 9, lines 28-30).
- h. Also noting page 9, line 28, reference numerals 48 and 60 refer to the same bracket; as noted above, only one reference numeral should refer to a part of the invention.
- i. Noting page 10, line 7, the lead lines for reference numeral 19 in Figures 4 and 5 are incorrect.
- j. Reference numeral 30 refers to a bellows on page 10, line 17 and a bracket on page 10, line 8.
- k. The bellows labeled 17 in Figure 2 is labeled 29 in Figure 5.
- l. In Figure 7, reference numeral 50's lead line should touch the part to which it refers (page 11, line 3, page 12, line 2).
- m. Noting page 11, line 5, reference numeral 48 refers to holes in Figure 7, but refers to a bracket in Figure 4.
- n. The part labeled 47 in Figure 7 is labeled 22 or 27 in Figure 5, apparently; also note reference numeral 47 in Figure 8. Great confusion exists over the structure of the invention because of the misuse of reference numerals.

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- o. Regarding page 12, line 7 it is not clear where the cushion material is in Figure 6 because the lead line for reference numeral doesn't touch the cushion.
- p. Reference numeral 59 (page 12, line 14) is not in Figure 9.
- q. Page 12, lines 17-20 are not clear because reference numeral 19 is mislabeled in Figure 4.
- r. Page 17, lines 28-30 are especially unclear. Apparently, "74" in line 30 should be "75". Also, contrary to this text, the bellows are not attached to the upper bracket by the lower plates.
- s. Noting page 18, line 20 reference numeral 96 is a plate, not a bellows in Figure 11, and reference numeral 91 is not on the drawings.
- t. The text from page 18, line 20 to the end of the specification is particularly confusing. Reference numeral 98 appears twice in Figure 11 representing two different parts. Reference numeral 96 refers to both a bellow and plate on page 18, lines 20-22.
- u. Reference numeral 105 (page 18, lines 27-28) is not on the drawings, and there is no bellows labeled 91 (page 18, line 27).

### ***Specification***

- 5. The abstract of the disclosure does not commence on a separate sheet in accordance with 37 CFR 1.52(b)(1). A new abstract of the disclosure is required and must be presented on a separate sheet, apart from any other text.

6. The disclosure is objected to because of the following informalities: The specification is replete with inaccuracies, misspellings and other informalities. While some are listed below, the specification should be reviewed and carefully rewritten.

Appropriate correction is required.

- a. Page 2, line 29 through page 3, line 2 are an incomplete sentence.
- b. The Brief Description of the Drawings should follow the Summary of the Invention on page 3 (please note that the Office cannot move text or "reinsert" the Brief Description after the Summary; applicant will have to cancel the Brief Description and copy its text in a future amendment and instruct the Office as to the page and line number where it is to be inserted).
- c. On page 6, line 13 "preferrably" should be "preferably". Note also page 13, lines 11 and 18-19.
- d. Page 6, lines 13-16 are an incomplete sentence ("it" in line 15 should be deleted).
- e. On page 7, line 9 "11" should be "11, 12". The same is true of page 7, line 10.
- f. On page 10, line 3 "method" should be "methods".
- g. On page 10, line 7 "has" should be "have".
- h. On page 11, line 3 and line 7 "removeably" should be "removably".
- i. On page 11, line 22 "slideably" should be "slidably".
- j. On page 11, line 24, "by" should be "be".

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- k. On page 13, line 13 a comma should follow "9".
- l. On page 16, line 16 "taylor" should be "tailor".
- m. On page 16, line 30 "moveable" should be "movable".
- n. On page 18, line 30 "and 11" should follow "110".
- o. On page 19, line 6 "forth" should be "fourth".

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are replete with lack of antecedent basis and double inclusion and instances of vague recitations. Although some examples follow, the claims should be carefully reviewed and rewritten.

- a. Regarding claim 1, the word "means" is preceded by the word(s) "spring" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).



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b. In claim 1, line 3 "relative each other" is indefinite because it should be "relative to" each other for proper grammar and because it is not clear what "each" refers to - the part, the frame or the spring means.

c. In claim 1, line 4, it is not clear from the claim language what "it" refers to, nor what "each part" refers to; this line is particularly unclear.

d. In claim 1(b) there is no antecedent basis for "the lower part".

e. In claim 1(c) there is no antecedent basis for "the top" and "the upper part".

f. In claim 1(d) "pressure adjustment means" is indefinite as per spring means above.

g. In claim 1(e) there is no antecedent basis for "said connecting tubing".

h. Throughout claim 2, lines 1-3 "a spring means", "an upper part", "a frame" etc., are double inclusions of the spring means, etc. already recited in claim 1, from which claim 2 depends. This occurs all through the remainder of the claims.

i. In claim 2(b) "moveably" is misspelled, and it is not clear what "each part" is (what parts of the invention previously recited does this include).

j. In claim 3, there is no antecedent basis for "each of the said lower parts", as only said [a] lower part was recited in claim 1 from which claim 3 depends.

k. In claim 4, "bellows means" is indefinite as per spring means above, and there is no antecedent basis for "each of said lower parts" as only said [a] part was recited in claim 1.

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l. Because the upper margin of page 2 of the claims is improper, parts of the first line of claim 4 were obliterated by hole punch when the papers were entered into the file. The first line of claim 4 should be replaced by amendment with applicant's next correspondence.

m. In claim 5, the governing orifice is a double inclusion of the governing orifice recited in claim 1.

n. Throughout claims 6-10 "an air bellows assembly" is a double inclusion of the air bellows assembly already recited in claim 1.

o. In claim 6, line 2 "a air" should be "an air" and "a" should follow "on".

p. In claim 9 there is not antecedent basis for "said spring" as a spring means was previously recited.

### ***Double Patenting***

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11

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F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-10 are rejected under the judicially created doctrine of double patenting over claims 1-17 of U. S. Patent No. 5,873,581 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: A bellows assembly with an adjustment means and orifice.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

11. Claims 1-10 are rejected under the judicially created doctrine of double patenting over claims 1-10 of U. S. Patent No. 5,271,638 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a bellows with an adjustment means and orifice.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-3 and 5 and 8 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Pribonic et al in view of Yamahara.

Pribonic et al discloses as best understood an air spring assembly 30 which would include an inflatable member or bellows 34 inflated with air (as it is an air spring unit) between parts (frame) 12 and leaf spring 22. The air bellows assembly 34 as best understood is mounted above leaf spring 22 and has its top secured to the upper part or frame 12 by a bracket as broadly recited, best seen in Figure 1, where a longitudinal member or bracket extends from the top of member 34 to the cross member of the frame 12. The assembly is attached to the air supply means 40 through manual

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adjustment means 38. It would have been obvious to one of ordinary skill in the art to modify Pribonic et al to include a governing orifice as functionally recited in the tubing connecting the spring to the source as taught by Yamahara's orifice 21 in order to gradually discharge air from the shock or spring (Yamahara, column 3, lines 1-15)(claim 1).

Regarding claim 2, the claim is so indefinite that the combination appears to meet its positive limitations. Pribonic et al teaches a lower bracket in Figure 2 connecting the bottom of shock absorber 32 to leaf spring 22. Claim 2 is full of double inclusions already discussed in claim 1 otherwise. In fact, claim 2(c) is inaccurate in reciting the air bellows assembly secured to the lower part near the top of the air bellows assembly, and as such, the combination appears to meet claim 2.

Similarly, claim 3 appears to be met by the combination, as there is at least one bellows 34 above each lower part 22 in Pribonic et al.

In regard to claim 5, as functionally and indefinitely recited, in the combination Yamahara's orifice would control rapid changes in air volume in the air bellows (incidentally, in claim 5, there is no antecedent basis for "said air bellows").

The total air capacity recited in claim 8 is an obvious matter of design choice, as the specification gives no stated reason or particular purpose for the specific range recited, and it the skilled artisan would set some capacity in this range or a similar range depending on the load anticipated to be encountered.

14. Claims 4 and 6-7 and 9-10 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Pribonic et al in view of Yamahara as applied to claim 1 above, and further in view of Whelan.

Whelan teaches as indefinitely recited at least two bellows 10, 11 used in conjunction with another spring or shock absorber in Figure 1. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pribonic et al and Yamahara above to include at least two bellows in line above each leaf spring as taught by Whelan in order to control height under load (Whelan, column 2, lines 1-20) using an alternative bellows arrangement in the art that would allow more cushioning (i.e., using two bellows for each leaf spring of Pribonic et al) (claim 4).

Regarding claim 6, the two bellows in the combination would be on the same lower bracket in keeping with Whelan, who teaches the two bellows on the same lower support in Figure 1.

In the combination Whelan's bellows are spaced apart (claim 7).

The values set in claims 9-10 are an obvious matter of design choice as discussed at the end of paragraph 13 above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Culbreth whose telephone number is (703) 308-0360. The examiner can normally be reached on M-F, First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on (703) 308-1113. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703) 308-2571 for regular communications and (703) 308-2571 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

ec

June 13, 2000



ERIC CULBRETH  
PATENT EXAMINER

6/13/00